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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,493	08/17/2009	Joshua Gur	147 06 01 NP US	1507
36131 7590 08/31/2011				
YORAM TSVION				
P.O. BOX 1307				
PARDES HANNA, 37111				
ISRAEL				
EXAMINER				
STOUT, MICHAEL C				
ART UNIT		PAPER NUMBER		
3736				
NOTIFICATION DATE		DELIVERY MODE		
08/31/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

erikav@patent2u.co.il
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Office Action Summary

Application No.

10/595,493

Applicant(s)

GUR ET AL.

Examiner

MICHAEL C. STOUT

Art Unit

3736

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-4, 6, 7, 10 and 11 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-4, 6, 7, 10 and 11 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI) Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

This detailed action is in regards to United States Patent Application 10/595,493 filed 10/24/2004.

The Amendment filed 6/21/2011 is being considered.

Specification

The amendment filed 6/21/2011 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: light is prevented from reaching the detector when the body is flattened.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 6, 7, 10 and 11 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The device is a tonometer which monitors the pressure of the body by measuring changes in the reflected light as pressure is applied to the body causing flattening of the body. The claims recite the

newly presented claim limitation of light prevented from reaching the sensor when the body is flattened, therefore the device cannot record changes is reflected light as the body is flattened to determine pressure.

As it is impossible to determine the pressure of the eye without monitoring changes in the reflected light as pressure is applied to the body causing the body to be flattened no significant art could be applied to the claims and no prior art rejection has been applied.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-4, 6, 7, 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 6 recite a method and device wherein a light detector does not receive light reflected from the body when in a flattened configuration wherein changes in the reflected light determines pressure of the body. The applicant's disclosed invention as originally filed discloses wherein light is detected by the detector prior to and during a flattened configuration and wherein the

changes in the refracted light resulting from a pressure deformation is used to calculate a pressure of the body, see page 7, line 12 through page 8, line 5, the specification further goes on to state that light is detected by the detector in the flattened state, see page 8, line 6 through page 9, line 16 which states A convex surface of the undistorted cornea implies a larger effective area, which reflects light back towards face 52 of Fig.

2. A planar surface has smaller effective area, which reflects this illuminating light towards face 52 of LPCT 48 of Fig. 2, and therefore correlates with a lower light intensity reflected. When certain threshold low reflection intensity is reached, a zero reflectance value is assigned and any lower light intensity reflected is interpreted as zero, even as the cornea assumes a concave structure (flattened). Features of intensity-time profile 100 are correlated with actual IOP values. IOP values are correlated with the time intervals in which light intensity changes from 5 its maximal value to zero and back again to its maximal value. As shown in Figure 3 the reflectance is measured from an initial unflattened maximum value through a range of flattened measurements to a reference value.

3. Claims 1-4, 6, 7, 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 6 recite a method and device wherein a light detector does not receive light reflected from the body when in a flattened configuration wherein changes in the reflected light determines pressure of the body. It is unclear to one

skilled in the art how to perform the method/make the device wherein pressure is determined by monitoring a reflectance of light off of a body by a detector wherein when light is prevented from reaching the detector when the body is flattened, it is unclear how to determine pressure of the body without using measurements of the light when flattened.

The applicant's disclosed invention as originally filed discloses wherein light is detected by the detector prior to and during a flattened configuration and wherein the changes in the refracted light resulting from a pressure deformation is used to calculate a pressure of the body, see page 7, line 12 through page 8, line 5, see page 8, line 6 through page 9, line 16.

Claim Rejections Under - 35 USC § 102 and 35 USC § 103

As the pressure of the body cannot be determined without monitoring changes in the reflected light as pressure is applied to the body causing the body to be flattened no significant art could be applied to the claims and no prior art rejection has been applied.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. STOUT whose telephone number is (571)270-5045. The examiner can normally be reached on M-F 7:30-5:00 Alternate (Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. C. S./
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736